

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRIAN BARBER

Appeal No. 2003-0653
Application No. 09/861,268

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11 to 18 and 22 to 27, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a blade for singulating a D-shaped blunt for a needle (claims 11 to 14 and 22 to 24) and an apparatus for fabricating a needle assembly having a needle and a blunt which fits within a cannula of said needle (claims 15 to 18 and 25 to 27). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 11 to 14 and 22 to 24 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the appellant's admission of prior art (specification, pages 3-4; Figures 1, 2A and 2B) relating to an apparatus for singulating blunts (Admitted Prior Art).

Claims 15 to 18 and 25 to 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of U.S. Patent No. 4,375,854¹ to Hedel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed September 26, 2002) for the examiner's complete reasoning in

¹ Issued March 8, 1983.

support of the rejections, and to the brief (Paper No. 10, filed April 11, 2002) and reply brief (Paper No. 17, filed October 28, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We sustain the rejection of claims 11 to 14 under 35 U.S.C. § 102(a) but not the rejection of claims 22 to 24.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert.

denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 11, 12 and 22 to 24 read as follows:

11. A blade for singulating a D-shaped blunt for a needle, said blunt being singulated from a collection of blunts in an assembly process for assembling said blunt into said needle, said blade comprising:
 - a main body;
 - a first end of said main body, said first end for coupling to a motor which moves said main body;
 - a tip end of said main body, said tip end being designed to capture securely only one D-shaped blunt, wherein a further D-shaped blunt is not securely maintained in said tip end.
12. A blade as in claim 11 wherein said blunt is designed to provide needle stick prevention and wherein said tip end has a cutout which is designed to capture securely only one blunt.
22. A blade as in claim 12 wherein the cutout is D-shaped.
23. A blade as in claim 12 wherein the tip end includes a tip raised above the cutout to protect a single D-shaped blunt in the cutout from a passing fluid.
24. An apparatus as in claim 23 wherein the tip end includes a tip raised above the cutout to protect a single blunt in the cutout from the passing fluid.^[2]

² It appears to us that claim 24 should not depend from claim 23 since claim 24 repeats limitations already recited in claim 23. Since claim 24 begins with "An apparatus" and not "A blade" perhaps claim 24 was intended to depend from claim 15 or 16.

Figure 1 of the Admitted Prior Art depicts a feeder 101 having a container 103 for holding a plurality of needles 107; a blade 105 disposed at least partially within a slot 111 of the container; and a motor 112 coupled to the blade for moving the blade up and down within the slot to singulate a blunt. The blade has a curved tip end 105A which as shown in Figure 1 has captured securely one needle. The appellant admits (specification, p. 3) that a feeder similar to Figure 1 has been used to singulate a blunt from a set of blunts in order to take the singulated blunt and then insert it into the cannula of a needle to assemble the needle assembly. The appellant then states that a D-shaped blunt presents a challenge for the feeder of Figure 1 since the blade 105 may not successfully singulate one blunt from the set of blunts as represented in Figures 2A and 2B. Figure 2A shows two D-shaped blunts 203, 205 side-by-side on the curved tip end 105A of the blade 105. Figure 2B shows one D-shaped blunt 209 supported directly on the curved tip end 105A of the blade 105 and another D-shaped blunt 207 supported directly on top of the D-shaped blunt 209.

With respect to claim 11, the appellant asserts that the Admitted Prior Art does not have a tip end designed to capture securely only one D-shaped blunt, wherein a further D-shaped blunt is not securely maintained in said tip end. We do not agree. The appellant's Figures 6A, 6B and 6C show various examples of how more than one D-shaped blunt can be picked up by the appellant's blade having a D-shaped cutout.

The appellant teaches (specification, p. 10) that in each case, the second blunt is significantly exposed and will not be maintained on the tip end of the blade after an air jet is pulsed to remove the second blunt. In our view, Figure 2B of the Admitted Prior Art clearly shows that tip end 105A securely captures only D-shaped blunt 209 since the other D-shaped blunt 207 on top of blunt 209 is not secured in the tip end 105A and would not be maintained on the tip end of the blade after an air jet is pulsed to remove the upper blunt 207. In addition, it is our opinion that Figure 2A of the Admitted Prior Art shows that neither D-shaped blunt is securely captured by the tip end 105A since both blunts would not be maintained on the tip end of the blade after an air jet is pulsed to remove both blunts.

With respect to claim 12, the appellant asserts that the Admitted Prior Art does not have a tip end having a cutout which is designed to capture securely only one blunt. We do not agree for the reasons provided above with respect to claim 11.

For the reasons set forth above, the decision of the examiner to reject claims 11 and 12 under 35 U.S.C. § 102(a) is affirmed.

The appellant has grouped claims 11 and 14 as standing or falling together and has grouped claims 12 and 13 as standing or falling together.³ Thereby, in accordance with 37 CFR § 1.192(c)(7), claim 14 falls with claim 11 and claim 13 falls with claim 12. Thus, it follows that the decision of the examiner to reject claims 13 and 14 under 35 U.S.C. § 102(a) is also affirmed.

With respect to claim 22, the appellant asserts that the Admitted Prior Art does not have a tip end having a D-shaped cutout. We agree. In that regard, the imaginary line drawn by the examiner in the blown up Figure 2B in the answer does not transform the curved tip end 105A (a C-shaped cutout) into a D-shaped cutout. In our view, at a minimum, a D-shaped cutout, consistent with the appellant's disclosure, requires both a straight vertical side and side curved outwardly from the lower end of the straight vertical side.

With respect to claims 23 and 24, the appellant asserts that the Admitted Prior Art does not have a tip end including a tip raised above the cutout to protect a single D-shaped blunt in the cutout from a passing fluid. We agree. As shown in Figures 1, 2A and 2B, the curved tip end 105A does not include any portion raised above the cutout

³ See page 4 of the appellant's brief.

(i.e., above the imaginary line drawn by the examiner in the blown up Figure 2B in the answer) to protect a single D-shaped blunt in the cutout from a passing fluid.

For the reasons set forth above, the decision of the examiner to reject claims 22 to 24 under 35 U.S.C. § 102(a) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 15 to 18 and 25 to 27 under 35 U.S.C. § 103.

Independent claim 15 reads as follows:

An apparatus for fabricating a needle assembly having a needle and a blunt which fits within a cannula of said needle, said apparatus comprising:
a container for holding a set of blunts;
a motor;
a blade, disposed at least partially within a slot of said container, said blade having a first end of a main body, said first end coupling said main body to said motor which is for moving said blade, and said blade having a tip end which is designed to capture securely only one blunt, wherein a further blunt is not securely maintained in said tip end;
a fluid source to stream fluid past the tip end.

In the rejection under 35 U.S.C. § 103 before us in the appeal (answer, p. 4), the examiner (1) ascertained⁴ that the Admitted Prior Art does not include a fluid source to stream fluid past the tip end; (2) determined that Hedel teaches a fluid source 86 to stream fluid past a tip end 22; and (3) concluded that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the Admitted Prior Art with a fluid source to stream fluid past the tip end, in light of the teachings of Hedel, in order to transport the blunt to another location after separating the blunt from the set of blunts.

The appellant argues that Hedel does not teach a fluid source to stream fluid past a tip end. We agree. Hedel teaches the use of a vacuum source 86 to generate suction at nozzles 54 and 56 sufficient to cause a stone 12 disposed in an indentation 28 on end 22 of rod 24 to be drawn into one of the nozzles when the stone is disposed adjacent to one of the nozzles. Thus, vacuum source 86 is not a fluid source to stream fluid past the indentation 28 on end 22 of rod 24 (i.e., the a tip end). Likewise, while air will also be drawn into a nozzle with the stone, there is no air source to stream air past

⁴ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

the indentation 28 on end 22 of rod 24. Accordingly, the subject matter of claim 15 is not suggested from the teachings of the applied prior art.⁵

For the reasons set forth above, the decision of the examiner to reject independent claim 15, and claims 16 to 18 and 25 to 27 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 11 to 14 under 35 U.S.C. § 102(a) is affirmed; the decision of the examiner to reject claims 22 to 24 under 35 U.S.C. § 102(a) is reversed; and the decision of the examiner to reject claims 15 to 18 and 25 to 27 under 35 U.S.C. § 103 is reversed.

⁵ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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